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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,245	08/31/2000	David A. Cordray	AUS9-2000-0403-US1	4517

35525                      7590                      09/12/2003

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EXAMINER

FLYNN, KIMBERLY D

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 09/12/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/653,245

Applicant(s)

CORDRAY ET AL.

Examiner

Kimberly D Flynn

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

This action is in response to Applicant's Response to Office Action filed June 23, 2003.

Claims 1-23 are presented for further consideration.

#### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 4, 10-13, 15, and 21-23 are rejected under 35 U.S.C. 102(e) as being unpatentable over McDowell et al. (U.S. Patent No. 6,438,583 hereinafter, McDowell).

In considering claims 1, 4, 11-12, 15, and 22, McDowell discloses a system and method for re-routing electronic mail messages, the method comprising:

determining whether the electronic mail message for a recipient is to be forwarded to another address associated with the recipient (*Col 8, lines 32-37, McDowell discloses the re-route server, after receiving e-mail; determines if the recipient of the e-mail is a re-route customer, wherein if the recipient is determined to be a re-route customer then it is determined that the e-mail for the recipient is to be forwarded to the recipient's "toAccount" address or another address provided by the recipient*);

while McDowell discloses the re-route server's mail software performing additional operations such as: interfacing to the re-route subscriber database to insert information about

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current events (e-mail status, sender, date, etc.)(*Col. 14, lines 37-46*), McDowell does not explicitly disclose wherein the e-mail status information inserted by the re-route server includes an indicator identifying the electronic mail message as being forwarded from an old address if the electronic mail message is to be forwarded to another address associated with the recipient.

Nonetheless, Examiner takes official notice that including an indicator in an electronic mail message identifying the mail message as being forwarded is well known in the art. Accordingly it would have been obvious to a person having ordinary skill to modify the inserted information (the e-mail status information or the indicator) to include information identifying the e-mail as being forwarded from an old address in order inform the user that the e-mail was sent from a known user or source, thereby ensuring more security in the case of spam mail, junk e-mail, or viruses. Therefore, the aforementioned limitation would have been an obvious modification to the system as disclosed by McDowell.

In considering claims 2 and 13, McDowell discloses sending the message after including the indicator (*col. 8, lines 40-43*).

In considering claims 8 and 19, McDowell discloses means for updating a billing database for including the indicator for the recipient (*col. 14, lines 45-46*).

In considering claims 10, 21, and 23 McDowell discloses a system and method for forwarding an electronic mail message comprising:

receiving a signal to forward the electronic mail message to another address (*col. 11, lines 12-21*);

while McDowell discloses the re-route server's mail software performing additional operations such as: interfacing to the re-route subscriber database to insert information about

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current events (e-mail status, sender, date, etc.)(*Col. 14, lines 37-46*), McDowell does not explicitly disclose wherein the e-mail status information inserted by the re-route server includes an indicator identifying the electronic mail message as being forwarded from an old address if the electronic mail message is to be forwarded to another address associated with the recipient.

Nonetheless, it would have been obvious to a person having ordinary skill to modify the e-mail status information to include an indicator identifying the e-mail as being forwarded from an old address in order inform the user that the e-mail was sent from a known and secure source. Therefore, the aforementioned limitation would have been an obvious modification to the system as disclosed by McDowell.

3. Claims 3,5-9, 14,16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDowell in view of Berkowitz (U.S. Patent No. 6,088,720 hereinafter, Berkowitz)

In considering claims 3,5-7, 9, 14,16-18, and 20, while McDowell discloses the system substantially as claimed McDowell does not expressly disclose wherein the indicator can be represented by one of the following: text in the body of the electronic message, an audio indicator, a presentation of a wave file, a graphical indicator, or an advertisement. However, it is well known for e-mail systems to have the capability to incorporate various attachments to e-mail such as text, sound clips, WAV files, video clips, and graphics as evidenced by Berkowitz (*col. 2, lines 20-24*). While most e-mail clients can accommodate the receipt of any type of file, some e-mail clients are limited to specific types.

It would have been obvious to a person having ordinary skill in the art to recognize the desirability and advantages of modifying the system as disclosed by McDowell to include

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indicators of different forms in order accommodate the specifications of the receivers' e-mail client. Therefore, the claimed limitation would have been an obvious modification to the system disclosed by McDowell.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-23 have been considered, but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D Flynn whose telephone number is 703-308-7609.

The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703-746-72388, for After Final communications

(703) 746-7239, for Official communications

(703) 746-7240, for Non-Official/Drafts.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-3900.

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Kimberly D Flynn  
Examiner  
Art Unit 2153

KF  
September 8, 2003



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SUPERVISORY PATENT EXAMINER  
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